

Remarks

In the Office Action mailed September 9, 2002, Claims 1-27 are held subject to a restriction requirement, the Examiner contending that the claims are directed to more than one invention as follows:

- Group I – Claims 1-11, which the Examiner contends are directed to a two-ply polyurethane composite;
- Group II - Claims 12-24, which the Examiner contends are directed to a method of making a two-ply polyurethane composite;
- Group III – Claim 25, which the Examiner contends is drawn to a different method of making a two-ply polyurethane composite; and
- Group III – Claims 26 and 27, which the Examiner contends are directed to a canal or ditch.

Applicants herein confirm the election made by Ms. Carolyn Sloane to prosecute the claims of Group I (Claims 1-11), however, Applicants wish to make such election without traverse, and therefore cancel Claims 12-27. Applicants reserve the right to file divisional application(s) to the non-elected subject matter.

In that same Office Action, Claims 1, 2, 5, 6, 10 and 11 are rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 4,968,542 issued to Gaspar et al. as evidenced by U.S. Pat. No. 5,464,919 issued to Sinclair and U.S. Pat. No. 5,674,565 issued to Kausch et al. Claims 1-8 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,872,784 issued to Payne in view of U.S. Pat. No. 5,421,677 issued to Adam et al. and vice versa. Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,872,784 issued to Payne in view of U.S. Pat. No. 5,421,677 issued to Adam et al. and vice versa and further in view of U.S. Pat. No. 4,582,750 issued to Lou et al. Claims 1-11 are rejected under 35 U.S.C. §112, second paragraph as being indefinite.

I. Rejections under 35 U.S.C. §112, second paragraph

Claims 1-11 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. The Examiner contends that there is no antecedent basis for the term

"solidifiable liquid polyurethane composition" and that the terms "rigid" and "soft, pliable" render those claims indefinite.

Applicants by this amendment have removed the terms "rigid" and "soft" from Claim 1 and have deleted the word "the" before "solidifiable liquid polyurethane composition" and replaced it with the word --a-- thereby obviating the need for antecedent basis for "solidifiable liquid polyurethane composition". Claim 7 has been amended to delete the word "rigid" therefrom and Claims 8 and 9 have been deleted to delete the word "soft" therefrom.

Applicants submit that because of the above-detailed changes, the claims are in compliance with 35 U.S.C. §112, second paragraph, and respectfully request the Examiner reconsider and reverse her rejection of Claims 1-11 under 35 U.S.C. §112, first paragraph, as being indefinite.

II. Rejections under 35 U.S.C. §102(b)

Claims 1, 2, 5, 6, 10 and 11 are rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 4,968,542 issued to Gaspar et al. as evidenced by U.S. Pat. No. 5,464,919 issued to Sinclair and U.S. Pat. No. 5,674,565 issued to Kausch et al. Applicants respectfully disagree with the Examiner.

The Examiner at page 6, paragraph 16, of the instant Office Action, admits that "...the material is formed from **similar** material as those of the applicant's (sic) invention...." (emphasis added) Applicants remind the Examiner that as stated in MPEP §2131, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully contend that the Examiner has failed to point to where Gaspar et al. does so. Gaspar fails to disclose a geotextile as part of his orthopedic support. Further, Applicants contend that Sinclair and Kausch et al. fail to provide evidence of such.

The instant specification at page 7, lines 7-9 states that, "As used herein, the term "geotextile" refers to any woven or non-woven porous blanket or mat which is produced from natural or synthetic fibers." Further at lines 11-14 of the same page that, "Geotextiles are used primarily to line earthen surfaces. Such liners may, however, also be used in lining roofs, ponds, reservoirs, landfills, and underground storage tanks, canals and ditches."

Therefore, Applicants respectfully request the Examiner reconsider and reverse her rejection of Claims 1, 2, 5, 6, 10 and 11 under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 4,968,542 issued to Gaspar et al. as evidenced by U.S. Pat. No. 5,464,919 issued to Sinclair and U.S. Pat. No. 5,674,565 issued to Kausch et al.

III. Rejections under 35 U.S.C. §103(a)

(A) As unpatentable over U.S. Pat. No. 4,872,784 issued to Payne in view of U.S. Pat. No. 5,421,677 issued to Adam et al. and vice versa

Claims 1-8 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,872,784 issued to Payne in view of U.S. Pat. No. 5,421,677 issued to Adam et al. and vice versa. Applicants respectfully disagree with the Examiner's contention regarding the cited art.

As stated in MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed Cir 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992).

Clearly, there is no such teaching, suggestion or motivation shown in the references in this case. Adams fails to disclose or suggest using more than one layer as admitted by the Examiner at page 8, paragraph 21, of the instant Office Action. Applicants aver that Payne fails to disclose or suggest that the two layers have different characteristics as is instantly claimed.

Therefore, Applicants contend that nothing in the combined teaching of Payne and Adam et al. would lead one of ordinary skill to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 1-8 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,872,784 issued to Payne in view of U.S. Pat. No. 5,421,677 issued to Adam et al. and vice versa.

(B) As unpatentable over U.S. Pat. No. 4,872,784 issued to Payne in view of U.S. Pat. No. 5,421,677 issued to Adam et al. and vice versa and further in view of U.S. Pat. No. 4,582,750 issued to Lou et al.

Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,872,784 issued to Payne in view of U.S. Pat. No. 5,421,677 issued to Adam et al. and vice versa and further in view of U.S. Pat. No. 4,582,750 issued to Lou et al. Applicants respectfully disagree with the Examiner's contention regarding the cited art.

Applicants respectfully remind the Examiner of the Federal Circuit's admonition in *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998), that

"To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." (Emphasis added.)

Applicants respectfully contend that the Examiner has failed to do so in the instant Office Action. Applicants' arguments with respect to Payne and Adams et al. as given above are equally applicable to the present rejection. Payne and Adams et al. fail to disclose or suggest the instantly claimed invention. Further, Lou fails to add the missing teaching or suggestion which would lead one of ordinary skill in the art to the instantly claimed invention.

If the Examiner is relying on knowledge generally available to one of ordinary skill in the art, MPEP §2144.03 states that if Applicants traverse such an assertion, the Examiner should cite a reference in support of her position. Applicants do traverse the Examiner's assertion in this case and hereby request such a reference. If the Examiner is relying on facts within her personal knowledge, Applicants respectfully request and are calling for, pursuant to MPEP §2144.03 and 37 C.F.R. §1.104, the Examiner to support such facts by an Affidavit.

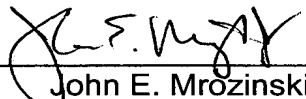
Therefore, Applicants contend that nothing in the combined teaching of Payne, Adam et al. and Lou et al. would lead one of ordinary skill to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claim 9 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,872,784 issued to Payne in view of U.S. Pat. No. 5,421,677 issued to Adam et al. and vice versa and further in view of U.S. Pat. No. 4,582,750 issued to Lou et al.

Conclusion

Applicants have cancelled Claims 12-27 and have amended Claims 1 and 7-9. Applicants contend that such amendments add no new matter and find support in the specification. Attached hereto, please find pages captioned "Version with markings to show changes made."

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 1-11. If the Examiner is of the opinion that the instant application is in condition for other than allowance, she is requested to contact the Applicants' Attorney at the telephone number given below so that additional changes to the claims may be discussed.

Respectfully submitted,

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Version with markings to show changes made

IN THE CLAIMS:

Claims 12-27 have been cancelled.

The claims have been amended as follows:

1. (Amended) A two-ply polyurethane geotextile composite in which a [rigid] dimensionally stable geotextile is bonded to a [soft] pliable geotextile with a [the] solidifiable liquid polyurethane composition which is a reaction product of a mixture comprising:

- a) a liquid polyisocyanate having an isocyanate content of at least 10% by weight,
- b) an isocyanate reactive component comprising a polyether polyol having from 2 to 6 hydroxyl groups and a number average molecular weight of from 250 to 8,000 and 0 to 10% by weight, based on total weight of b), of a low molecular weight diol or triol having an equivalent weight of from 31 to 99,
- c) a urethane catalyst, and optionally,
- d) a filler.

7. (Amended) The composite of Claim 1, wherein the [rigid] dimensionally stable geotextile has a maximum thickness of 1 mm.

8. (Amended) The composite of Claim 1, wherein the [soft] pliable geotextile has a minimum thickness of 1 mm.

9. (Amended) The composite of Claim 1, wherein the [soft] pliable geotextile has at least one side burnished.

As explicitly set forth in **37 C.F.R. Section 1.121(c)(1)(ii)**, **last sentence**, a marked up version does not have to be supplied for an added claim or a cancelled claim as it is sufficient to state that a particular claim has been added, or cancelled, and this has been so stated in the Amendment.

In particular, in the instant application, Claims 12-27 have been cancelled.